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REMARKS

Claims 1-26 and 51 remain in the application. Claims 1, 15, and 51 are in independent form.

Claims 1-26 and 51 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Specifically, the Office Action holds that claims 1-26 are considered software per se and suggests that the rejection can be overcome by claiming an inference to some form of hardware. In response thereto, Applicant has amended independent claims 1 and 15 to include a reference to a "computer-readable medium". The claims now reference a tangible computer system. The Office Action also holds that claim 51 simply manipulates abstract ideas without practical application in the technological arts. In response thereto, Applicant has amended independent claim 51 to include references to the use of a computer processor to accomplish the method steps. The abstract ideas now have reference to a concrete computer processor. Reconsideration of the rejection under 35 U.S.C. §101 is respectfully requested.

Claims 1, 3-4, 6-9, 15-17, and 19-21 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Office Action holds that the claims are single means claims. According to MPEP §2164.08(a), a single means claim rejection is due to the fact that "the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor." In response thereto, Applicant has amended the claims to change "augmenting means" to "selection option mechanism" to further define the invention. Support for the amendment is found in the specification. See page 17, line 23 – page 18, line 2: "The augmenting mechanism is a selection option mechanism that further includes mechanisms for adding and substituting related information." See also page

18, lines 8-9. Reconsideration of the rejection under 35 U.S.C. §112, first paragraph, is respectfully requested.

Claims 6, 7, and 19 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office Action holds that the term "intelligently suggesting more information" lacks comparative basis. In response thereto, Applicant has amended claims 6 and 19 to delete "more" to obviate the need for comparative basis. Claim 7 ultimately depends on claim 6, therefore the amendment to claim 6 overcomes the rejection of claim 7. Reconsideration of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

Claims 1-26 and 51 stand rejected under 35 U.S.C. § 102(e), as being anticipated by U.S. Patent No. 5,660,176 to Iliff. Specifically with respect to the independent claims, the Office Action holds that Iliff teaches that in situations where the MDATA system 100 cannot determine with sufficient certainty what is causing a particular problem or in a situation where a diagnosis is available but additional information is desirable, a re-enter flag may be set by the system 100 so that a telephone consultation can allow for the addition of information to the patient record. Various telephone numbers can be used to access the MDATA system 100. CPT-4 codes are used for reporting medical services and procedures. The MDATA system's authoring language is designed to allow physicians to transfer their knowledge into a computer program that can be directly accessed by non-medically trained personnel. Reconsideration of the rejection under 35 U.S.C. § 102(e), as anticipated by the Iliff patent, as applied to the claims, is respectfully requested. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231

U.S.P.Q. 81 (Fed. Cir. 1986) it was stated: "For prior art to anticipate under §102 it has to meet every element of the claimed invention."

In <u>Richardson v. Suzuki Motor Co., Ltd.</u>, 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) it was stated: "Every element of the claimed invention must be literally present, arranged as in the claim."

The MDATA system of the Iliff patent is directed to a <u>telephone system</u> for use by persons seeking medical advice who do not have time to talk to their physician or go to a doctor's office for an appointment, wherein a person can call a number and interact with the system to generate medical advice. (Col. 3, lines 30-36) "The medical algorithms used by the MDATA system are designed for use in a telecommunications setting and overcome the deficiencies of self-help books." (Col. 3, lines 42-45) Thus, it is the goal of the system to provide information for on medical conditions to people seeking advice, not through their doctor nor in an inpatient setting, but over the phone. It is possible to use CPT-4 codes to describe and bill third party payers for <u>telephone consultations</u>. In other words, the person calling for medical advice is not generating any inpatient medical services, but only a telephone call which the agency or hospital can be reimbursed for by an insurance company. Therefore, it is not necessary for the MDATA system to elicit information to generate accurate codes to comply with governmental regulatory coding requirements. Not only is the person using the system not receiving any billable medical treatment besides advice over the phone, the person is not in a medical facility where the need for accurate coding of exams, tests, and services is important to the accurate reimbursement of the medical facility. Thus, the Iliff patent does not contemplate the problem of inaccurate coding leading to incorrect reimbursement through physician-entered data about an inpatient stay.

In contradistinction, the system as defined in the presently amended independent claims is directed to a clinician documentation system including

a selection option mechanism for eliciting information for medical codes through the analysis of clinician-entered information and predetermined criteria input, the selection option mechanism prompting a user to enter detailed information at the time of inpatient services to better comply with governmental regulatory coding regiments in order to classify an inpatient stay appropriately to obtain an accurate payment. There are thousands of coding rules and some are dependent on specific information or verbiage that the clinician uses to document the patient's condition and the clinician's observations and conclusions. Thus, the present system is designed for use by a clinician interacting with a patient in an inpatient setting, not a patient interacting with a computer program over the phone where the level of detail in generating a code is not a concern. With the many procedures that go on in an inpatient setting, it is important that an appropriate bill is generated. Support for the amendment of claims 1, 15, and 51 can be found in the specification. "In order to receive the appropriate level of payment reimbursement, the proper medical billing codes must be assigned to the services rendered by the health care provider. In turn, proper medical billing codes will determine the level of reimbursement. The description of the appropriate services rendered is crucial in ultimately determining payment reimbursement. Therefore, accurate and complete documentation of the patient encounter must meet certain criteria in order to be assigned to the appropriate medical billing code." (Page 3, lines 11-18) The Iliff patent, only needing to generate a code for a telephone call giving medical advice, does not contemplate the complexity of generating an appropriate code and the need for detailed information given by the clinician to generate an accurate payment in an inpatient setting.

Furthermore, the MDATA system of the Iliff patent does not disclose an augmenting means (i.e. selection option mechanism) as defined in the present invention and the currently amended independent claims. "In situations where the MDATA system 100 cannot determine with sufficient certainty what is causing a particular problem (no diagnosis) or in a situation

where a diagnosis is available but additional information is desirable, e.g., to determine a trend, a re-enter flag may be set by the system 100. At a decision state 520, the computer 102 determines if re-enter criteria are met for the current algorithm and patient situation. If so, the computer sets the re-enter flag at state 522 for this problem so <u>a subsequent telephone consultation</u> by the patient will allow for additional information to be added to the patient record by the system in full knowledge of the previous call." (Col. 42, lines 22-33) In other words, more than one encounter with the patient at subsequent times to the first encounter may be needed to gain information to provide an accurate diagnosis. The computer does not try to gain additional information at the time of the first call. There is no prompting by the computer 102 to enter further detailed information at the time of the first encounter.

The selection option mechanism of the present invention, in contrast, prompts the user to enter detailed information at the time the patient is in the inpatient setting, and does not require subsequent patient encounters in order to elicit accurate information. "Augmenting is achieved in response to a prompting, wherein the user notes additions or substitutions to the criteria and/or conclusions and makes adjustments accordingly." (Page 11, lines 12-14) The prompting is also related to the need for appropriate classification of inpatient services for compliance with governmental billing codes. When generating the correct code to submit for reimbursement by insurance companies, accurate information is required <u>at the time of the patient's inpatient services</u>, not at a subsequent inpatient encounter should they need to come back for more services. "Each information prompting form contains different prompts that query the health care provider to supply data or information regarding the patient encounters." (Page 23, lines 7-9) "The augmenting mechanism improves the accuracy of the medical coding and the overall quality of patient care by influencing the physician's decisions <u>at the time of patient care delivery</u>." (Page 25, lines 11-13) Thus, while the patient is receiving inpatient services, the clinician can enter information in the system, and while doing so, is prompted at different points of the program to

give additional or detailed information to accurately generate a billing code.

Therefore, since the Iliff patent does not disclose a system which elicits information from clinicians to better comply with governmental regulatory coding regiments in order to classify an inpatient stay appropriately to obtain an accurate payment, nor does the Iliff patent disclose a selection option mechanism that prompts the clinician for detailed information at the time of inpatient services, as set forth in the presently pending independent claims, reconsideration of the rejection under 35 U.S.C. §102(e) is respectfully requested.

The remaining dependent claims not specifically discussed herein are ultimately dependent upon the independent claims. References as applied against these dependent claims do not make up for the deficiencies of those references as discussed above, and the prior art references do not disclose the characterizing features of the independent claims discussed above. Hence, it is respectfully submitted that all of the pending claims are patentable over the prior art.

It is respectfully submitted that the present amendment places the application in condition for allowance as it removes all remaining issues in dispute. Specifically, the amendment adds language suggested by the Office Action that was relied upon in arguments but was not present in the claims. The claims have been made no broader in scope thereby requiring no further searching and raising no new issues. Rather, the amendments have been made in view of comments made in the Office Action that clearly distinguish the presently pending claims over the cited prior art. Hence, it is respectfully requested that the amendment be entered.

This amendment could not have been made earlier as the amendment further defines over the prior art in accordance with the suggestion made in the Office Action, the suggestion first being made in the outstanding Office

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Action.   Hence, since there remain no further issues to be resolved, it is respectfully requested that the present amendment be entered.

In conclusion, it is respectfully requested that the present amendment be entered in order to place the application in condition for allowance, which allowance is respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

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CERTIFICATE OF MAILING/FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile (571) 273-8300 to the Patent and Trademark Office on December 16, 2005.

Connie Herty